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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,759	12/11/2003	Thomas John Goodwin	MSC-22859-3-CU	2623

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HOUSTON, TX 77058

EXAMINER

CHONG, KIMBERLY

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,759	<b>Applicant(s)</b> GOODWIN ET AL.	
	<b>Examiner</b> Kimberly Chong	<b>Art Unit</b> 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 36-44 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Status of the Application***

Claims 36-44 are currently pending in the instant application. Claim 43 is improper because it depends on a cancelled claim and further cannot properly be grouped into any of the inventions listed below. Appropriate correction is required.

Thus, claims 36-42 and 44 are subject to restriction as per below.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 36-41, drawn to a method of monitoring renal tubular epithelial differentiation, classifiable in class 436, subclass 6.
- II. Claim 42, drawn to a method of producing active renal epithelial cells, classifiable in class 435, subclass 325.
- III. Claim 44, drawn to a method of producing active 1,25-dihydroxy vitamin D<sub>3</sub>, classifiable in class 435, subclass 70.1.

The inventions are distinct, each from the other because of the following reasons:

The methods of groups I-III are all unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different methods are not disclosed as useful together because they have materially different

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modes of operation with different effects. For example, the method of group I, drawn to a method of monitoring renal tubular epithelial differentiation by monitoring expression of greater than one gene in an array is not disclosed as capable of use in the method of group II, drawn to a method of producing active renal epithelial cell. The methods of group I and II are not disclosed as capable of use in the method of group III, drawn to a method of producing active vitamin D3. Furthermore restriction is proper because the subject matter is divergent and non-coextensive and a search for one would not necessarily reveal art against the other. It is therefore a burden to search these inventions in a single application.

Furthermore, should applicants elect to prosecute group I, this group is subject to further restriction as follows. Claims 37, 39 and 41 are subject to an additional restriction since it is not considered to be a proper genus/Markush. See MPEP 803.02 – PRACTICE RE MARKUSH-TYPE CLAIMS – if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 300 (CCPA 1980); and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In *re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds

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included within a Markush group (1) share a common utility, and (2) share a substantial structure feature disclosed as being essential to that utility.

Claims 37, 39 and 41 specifically claims genes as listed, which can be expressed from differentiated renal tubular epithelial cells. Although the genes claimed each can be expressed from differentiated renal tubular epithelial cells, the instant genes are considered to be unrelated, since each gene claimed is structurally and functionally independent and distinct for the following reasons: each gene has a different structure and each gene has a particular associated function. As such the Markush/genus of genes in claims 37, 39 and 41 are not considered to constitute a proper genus, and are therefore subject to restriction. Furthermore, a search of more than one (1) of the genes claimed in claims 37, 39 and 41 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed genes. In view of the foregoing, one (1) gene is considered to be a reasonable number of genes for examination. Accordingly, applicants are required to elect a total of one (1) genes from claims 37, 39 and 41. Note that this is not a species election.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Chong whose telephone number is 571-272-3111. The examiner can normally be reached Monday thru Friday between 7-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

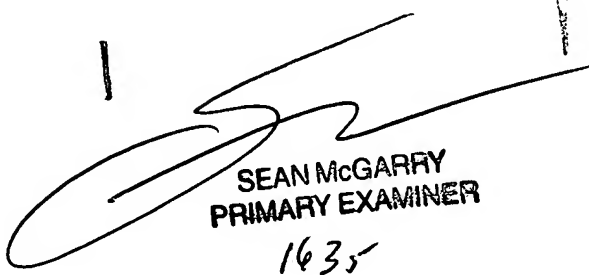
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the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Kimberly Chong  
Examiner  
Art Unit 1635



SEAN MCGARRY  
PRIMARY EXAMINER  
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